

REMARKS

Claims 1-20 are currently pending in the application. No claims have been amended herein. Accordingly, following the entry of this paper, claims 1-20 will be pending in the application.

Claims 1, 3-9, 11-15, 17 and 19 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,091,835 to Smithies et al.(hereinafter referred to as "Smithies") in view of U.S. Patent No. 6,901,509 ("Kocher"). Applicants respectfully traverse the rejection.

With respect to independent claim 1, the claim is directed to a method for electronically signing an electronic transcript, comprising: (a) performing a first hash operation on the electronic transcript to generate a representation of the contents of the electronic transcript; (b) concatenating data to the representation of the contents of the electronic transcript, said data identifying a user; (c) performing a second hash operation on the data concatenated to the representation, the second hash operation generating a representation of the contents of the electronic transcript and the data; (d) providing for the recording and time stamping by a digital notary service of the representation of the contents of the electronic transcript and the data; (e) obtaining a notary record from the digital notary service of the time stamping; (f) digitally signing the notary record; and (g) forming an electronically signed electronic transcript by bundling the digitally signed notary record with the electronic transcript and with the data identifying the user.

Applicants submit that the Examiner has not established *prima facie* obviousness based on the Smithies reference. As described in MPEP § 2142, in order to establish a *prima facie* case of obviousness, the Examiner must provide (i) some suggestion or motivation to modify the reference, (ii) a reasonable expectation of success, and (iii) the prior art reference must teach or suggest all of the claim limitations. The references do not teach or suggest all of the claim limitations of claim 1. In particular, as the Examiner admits, Smithies does not teach or suggest

“concatenating data to the representation of the contents of the electronic transcript, said data identifying a user,” and “performing a second hash operation on the data concatenated to the representation, the second hash operation generating a representation of the contents of the electronic transcript and the data.” As defined by the claim, the “representation of the contents of the electronic transcript” is the result of step (a) in the claim, namely the performing of a first hash on an electronic transcript.

Smithies is directed to authentication of electronic signatures in computer-based recording or transcribing systems. Particularly, Smithies is directed to a “ceremony” of affirmation that verifies the identity of a user and verifies that the user actually understands that their electronic signature is a binding affirmation of the recitations of the ceremony and the document being signed, similar to the understanding a person has when physically signing a piece of paper. As described at column 14, lines 5-21, the integrity of the provisions or undertakings of a document, transaction or statement may be verified using a one-way hash operation. As described in Smithies, a transcript generator module creates a one-way hash corresponding to the contents of the document, transaction or statement. This hash encoding may be compared to a hash encoding of a later copy of the document, transaction or statement to verify that the document, transaction or statement has not been modified since the time of affirmation. Smithies thus teaches performing a hash operation at the time of the affirmation, the result of which is then compared with results of a hash operation performed at a later time. In this manner, it may be verified that the contents of the document, transaction or statement have not been modified since the time of the affirmation.

Importantly, Smithies teaches only a hash operation on a document, and has no teaching or suggestion of a second hash operation on data concatenated to a representation as required by the claim. The second hash operation that the Examiner refers to is a hash of only the document that is performed at a later time in order to verify the contents of the document have not been altered. Thus, two separate hash operations are performed on the same document, one to generate the initial hash, and the other to generate a separate hash that is to be compared to the initial hash and verify the document is not changed from the time of the initial hash. This second hash of the document as disclosed in Smithies does not provide any teaching or suggestion of a hash operation performed on anything except the document itself.

Furthermore, because Smithies contains no teaching, suggestion, or motivation for concatenating data to a representation and performing a second hash operation on the data concatenated to the representation, Smithies also contains no teaching of “providing for the recording and time stamping by a digital notary service of the representation of the contents of the electronic transcript and the data; obtaining a notary record from the digital notary service of the time stamping; digitally signing the notary record; and forming an electronically signed electronic transcript by bundling the digitally signed notary record with the electronic transcript and with the data identifying the user.”

The Examiner relies on Kocher for the deficiencies of Smithies noted above. In particular, the Examiner the Examiner relies on the following points (reproduced from the Office Action at Pages 3 and 4):

concatenating data to the representation of the contents of the electronic transcript, said data identifying a user (ie., set the terms of document . . . transcript generator . . . creates secure record) (col 12, lines 28-40) (ie., evidence to corroborate . . . transcript generation module collects (col. 13, lines 52-60) (see Fig. 4b, item 518 shows a GUI that starts the process for gathering (equivalent to concatenating) data that represents the electronic transcript, upon approval, the data entered/verified is gathered);

performing a second hash operation on the data concatenated to the representation, the second hash operation generating a representation of the contents of the electronic transcript and the data (ie., hashing the result of concatenating the next hash with R, with cryptographic has functions)(col 10, lines 15-25).

The applicants have attempted to review the sections identified by the Examiner as to what Kocher discloses, however, the applicants cannot find any reference in Kocher at column 12, lines 28-40 regarding “set the terms of document . . . transcript generator . . . creates secure record” and, therefore, find it impossible to address the specific comments of the Examiner. Moreover, Kocher does not have a column 13, lines 52-60, as column 13 only extends to line 37. Furthermore, Kocher does not have a Figure 4b or an item 518 or even mention a graphical user interface or GUI. Thus, the applicants cannot address the Examiner’s specific comments. Thus, it is respectfully submitted that Kocher does not disclose “concatenating data to the representation of the contents of the electronic transcript, said data identifying a user” and as such does not cure the admitted defect of Smithies. As such, claim 1 is patentably distinct from

Smithies and Kocher either alone or in any reasonable combination thereof. Withdrawal of the rejection of claim 1 and allowance of the claim is respectfully requested.

Moreover, Kocher does not disclose “concatenating data to the representation of the contents of the electronic transcript, said data identifying a user” and “performing a second hash operation on the data concatenated to the representation, the second hash operation generating a representation of the contents of the electronic transcript and the data,” as suggested by the Examiner. Rather, Kocher teaches or discloses a method to hash a data file. In particular, the data file is processed into a plurality of ranges. A hash tree is then built from the plurality of ranges. The hash, however, is simply the data file broken into a plurality of ranges. Once the data file is hashed, a digitally signature is appended to the hashed data file. See for example, US Patent 6,901,509 to Kocher at column 8, lines 24-31, stating: “To summarize, the tree issuer thus performs the following steps: 1. Construct the list of items, 2. Convert list into a set of ranges, 3. Build an interval hash tree from the ranges, 4. Digitally sign the hash tree’s root node, and 5. Publish the hash tree and signed root node.” As is evident from the summary, the digital signature is appended after the hash operation and not separately hashed. Thus, Kocher does not teach or suggest the step of “concatenating data to the representation of the contents of the electronic transcript, said data identifying a user” and “performing a second hash operation on the data concatenated to the representation, the second hash operation generating a representation of the contents of the electronic transcript and the data.” Because neither Smithies (as admitted by the Examiner) nor Kocher disclose “concatenating data to the representation of the contents of the electronic transcript, said data identifying a user” and “performing a second hash operation on the data concatenated to the representation, the second hash operation generating a representation of the contents of the electronic transcript and the data,” claim 1 is patentably distinct from the references either alone or in any reasonable combination thereof. Thus, withdrawal of the rejection of claim 1 and allowance of the claim is respectfully requested.

Claims 7, 8, 9, 17, and 19 contain recitations similar to the recitations of claim 1 noted above and, at least by virtue of the similarity, are patentably distinct from Smithies and Kocher either alone or in any reasonable combination thereof. Furthermore, claims 3-6 and 11-15 depend (directly or indirectly) from claims 1 and 9. It is submitted that each of these dependent claims is also allowable for at least the same reasons as claims 1 and 9.

Claims 2, 10, 16, 18 and 20 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Smithies patent in view Kocher in further view of U.S. Patent No. 6,336,188 to Blake-Wilson et al. (hereinafter referred to as "Blake-Wilson"). Applicants respectfully traverse the rejection.

Claim 2 depends from independent claim 1. Claims 10 and 16 depend from independent claim 9. Claim 18 depends from independent claim 17. Claim 20 depends from independent claim 19. Each of the independent claims has been previously discussed, and because Blake-Wilson does not cure the defects of Smithies or Kocher noted above, Applicants submit that dependent claims 2, 10, 16, 18, and 20 are each allowable for at least the same reasons as described with respect to the respective independent claims.

No claim related fees are believed to be due with this response. In the event any such fees are due, please debit Deposit Account 08-2623.

The application now appearing to be in form for allowance, reconsideration and allowance thereof is respectfully requested.

Respectfully submitted,

HOLLAND & HART LLP

By: 

Brian Kinnear
Registration No. 43,717
P.O. Box 8749
Denver, Colorado 80201-8749
(303) 295-8000

Date: 3/22/06

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